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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,424	03/08/2004	Eric A. Nyberg	14185-B	1883

29171 7590 05/17/2007
BATTELLE MEMORIAL INSTITUTE
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EXAMINER

MAI, NGOCLAN THI

ART UNIT	PAPER NUMBER
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1742

MAIL DATE	DELIVERY MODE
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05/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,424

Applicant(s)

NYBERG ET AL.

Examiner

Ngoclan T. Mai

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8,24-27,29-39,41-53 and 152 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41,42 and 152 is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 24-26 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 27, 29-35, 37-39, 43-53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-2, 4-6, 8, 24-27, 29-39, 41-53 and 152 remain for examination. Claim 1 is currently amended and claim 152 is new.

Response to Arguments

2. Applicants' arguments filed 3/17/07 have been fully considered.

Regarding claims 1-2, 4 and 5 being rejected under 35.U.S.C. 102(b) as being anticipated by JP 7901021 and claims 1-2, 4-6, 8, 24-27, 29-35, 37-39 and 41-45 being rejected under 35.U.S.C. 103(a) as being unpatentable over JP 04116104 in view of Hermann are persuasive and the rejections of these claims over the references are withdrawn. However claims 1, 2, 4, 5, 24-26 remain rejected for the reasons as follows.

Applicants essentially argue on page 10 that chlorine present in the organic binder, i.e., chlorinated naphthalene taught by Broodo is well known to those having skill in the art to be property-degrading impurity when it contaminates article of reactive metal, i.e., chlorine present in the feedstock introduces other impurities during the removal of Cl. and for this reason Broodo fails to teach the composition of the claimed invention, which additional recite that the aromatic binder and the metal powder "do not chemically interact with one another to form property-degrading impurities in articles resulting from application of the powder metallurgy forming techniques to the feedstock." The examiner answers is that there is no evidence by the teaching of Broodo of such property-degrading impurity nor do applicants cite any reference to support this fact. Applicants therefore fail to substantiate their position by factual evidence that the chlorine in one of the binders of Broodo would form such property-degrading impurities to the film forming metal disclosed

Art Unit: 1742

by Broodo. Note that mere argument or conclusory statements in the specification is not sufficient. In re Geisler (CAFC) 43 USPQ2d 1362 (7/7/1997).

For the above reason claims 1-2, 4 and 5 are still rejected as being anticipated by Broodo.

As for the rejection of claims 1-2 and 4-5 over US 220/0057980 (Morita) in view of U.S. Patent No. 3,302,073 (Broodo), applicants essentially argue that Morita teaches mixing a metal powder with an organic binder being dissolved in an organic solvent and fails to teach a feedstock wherein the aromatic binder and the metal powder are mixed. The examiner disagrees in that there is no difference between the claimed mixture and that of the prior Morita because the claimed composition does not exclude the present of solvent or the binder being dissolved in solvent before is mixed with the metal powder. Applicants also argue that Morita teaches away from the applicant's claimed invention, which is directed toward feedstock used to form dense articles of reactive metal by powder metallurgy, page 11. The examiner's answer is that the claimed invention is a composition claim and that the intention forming the composition into dense article does not lend patentability to the composition. A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. See *In re Lemin*, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273 (1964), *In re Thuau* 135 F.2d 344, 57 USPQ 324 (CCPA 1943), *Ex parte Douros* 163 USPQ 667 (POBA), and *In re Craige*, 188 F.2d 505, 89 USPQ 393 (CCPA 1951).

Applicants additionally argue that the Morita when combined with Broodo do not teach the claimed composition because as discussed above Broodo does not teach or suggest the currently amended claims which recites, in part, an aromatic binder and the metal

Art Unit: 1742

powder "do not chemically interact with one another to form property-degrading impurities in articles resulting from application of the powder metallurgy forming techniques to the feedstock." The examiner's response is Broodo is utilized as secondary reference to establish a prima facie case of obviousness to support examiner's position that aromatic binder in the amount of up to 15% by weight was known to bind reactive metal powder such as tantalum powder for forming consolidated product by powder metallurgy. Furthermore, applicants fail to substantiate their position by factual evidence that the chlorine in one of the binders of Broodo would form such property-degrading impurities to the film forming metal disclosed by Broodo. Note that mere argument or conclusory statements in the specification is not sufficient. In re Geisler (CAFC) 43 USPQ2d 1362 (7/7/1997). There is no evidence by the teaching of Broodo of such property-degrading impurity nor do applicant cites any reference support this fact.

For the above reasons claims 1-2, 4, 24, 25 and 26 are still rejected as being unpatentable over Morita in view of Broodo.

3. Claims 6, 8, 27, 29-35, 37-39, 43-53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 41-42 and 152 are deemed allowable.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1742

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

n.m.


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700